



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/435,316	11/04/1999	GARY PARSONS	XM-0015	5074

7590 12/01/2003

WILLIAM J BENMAN
BENMAN AND COLLINS
2049 CENTURY PARK EAST SUITE 2740
LOS ANGELES, CA 90067

EXAMINER

BAYARD, EMMANUEL

ART UNIT	PAPER NUMBER
----------	--------------

2631

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/435,316

Applicant(s)

PARSONS ET AL

Examiner

Emmanuel Bayard

Art Unit

2631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2631

DETAILED ACTION

1. This is in response to RCE filed on 10/20/03 in which claims 1-32 are pending. The applicant's amendment has been fully considered but they are moot based on the new ground of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 15 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomimori U.S. Patent 6,456,841 B1.

Art Unit: 2631

As per claims 1, 15 and 25, Tomimori discloses a receiver comprising: a first means for receiving (see figs. 1-3 element 1 and col.4, lines 29-30) a transmitted signal and providing an instantaneous output signal in response thereto; a second means for storing (see fig. 3 and element 21 and abstract and col.4, lines 47-67) at least a portion of said received signal; third means (see abstract) for providing replay signal; and fourth means (see fig. 3 element 24 and abstract, and col.4, lines 30-39 and col.13, lines 27-43) for selectively outputting said stored portion of said received signal or said instantaneous output signal in response to said replay signal; receiving means, storing means, replay and selection means disposed on a common mobile platform (see figs. 1-3 element 1).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katta et al U.S. Patent No 6,353,444 B1 in view of Farris et al U.S. Patent 6,617,253.

As per claims 1, 15 and 25, Katta et al discloses a receiver comprising: a first means for receiving (see figs. 3, 16, 25 and 35 elements 1140, 5110, 7110 and col.12, lines 19, 35 and col.26, lines 1, 28)) a transmitted signal and providing an instantaneous output signal in response thereto; a second means for storing (see figs. 3, 16, 25 and 35 elements 1120, 5160, 7170 and

Art Unit: 2631

col.8, lines 46-47 and col.9, lines 33-36, 50-64) at least a portion of said received signal; third means (see figs. 3, 16, 25 and 35 elements 1160, 5130 and col.16, lines 22-23 and col.12, line 36 and col.13, line 21-22 and col.36, line 11) for providing replay signal; and fourth means (see figs. 13, 16, 25 and 35 elements 9300, 1300, 5300, and col.2, lines 20-26 and col.13, lines 27-43) for selectively outputting said stored portion of said received signal or said instantaneous output signal in response to said replay signal.

However Katta et al does not teach said receiving means, storing means, replay and selection means disposed on a common mobile platform.

Farris et al teaches receiving means, storing means, replay and selection means disposed on a common mobile terminal which is considered as the claimed (mobile platform) (see abstract and col.1, lines 60-65 and col.5, lines 28-55 and col.6, lines 30-57 and col.16, lines 8-67).

It would have been obvious to one skill in the art to incorporate the mobile terminal of Farris et al into Katta as to provide interactive selection of information data messages, voice mail and electronic to users where the information are to be delivered or transmitted to a portable moveable telephone like device as taught by Farris (see col.4, lines 42-48).

As per claim 2, the receiver of Katta does include a radio frequency tuner (col.13, line 12).

As per claim 3, the receiver of Katta does include an audio decoder (see col.13, line 13).

As per claim 4, the receiver of Katta does include an user interface (see col.8, line 58).

Art Unit: 2631

As per claim 5, the receiver of Katta does include a system controller (see figs. 1, 3 16 elements 9300, 1300).

As per claims 6 and 16, the mobile terminal of does include a microprocessor (see fig. 7 element 104). Furthermore implementing such microprocessor into Katta would have been obvious to one skilled in the art so that the MPEG decoder may be controlled in response to signals from the microprocessor as taught by Farris (see col.20, lines 32-24).

As per claims 7 and 17, the receiver of Katta does include a software (see col.19, line 65).

As per claims 8-14, 18-24 and 26-32, the receiver of Katta does include a software for detection of codes (see fig.3 element 1150 and col.13, line 20).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Bayard whose telephone number is (703) 308-9573. The examiner can normally be reached on Monday-Thursday from 8:00 AM - 5:30 PM. The examiner can also be reached on alternate Fridays.

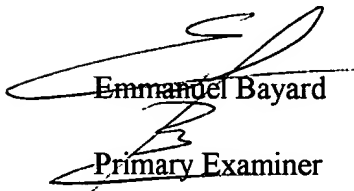
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad H. Ghayour , can be reached on (703) 306-3034. The fax phone number for this Group is (703) 872-9314.

Application/Control Number: 09/435,316

Page 6

Art Unit: 2631

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.



Emmanuel Bayard
Primary Examiner

November 24, 2003